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10/037,632	01/03/2002	Douglas C. Williams	69035-001	6756

7590

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EXAMINER

EGAN, BRIAN P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

cf

<b>Office Action Summary</b>	<b>Application No.</b> 10/037,632	<b>Applicant(s)</b> WILLIAMS, DOUGLAS C.	
	<b>Examiner</b> Brian P. Egan	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9, 11, 12 and 24-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 12, and 24-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Interpretation***

1. As noted in the previous office action, the phrase “pre-assembled” in claim 9 has been given patentable weight by the examiner. However, the examiner would like to clarify that claims 26, 31, and 36 still comprise method limitations that are given little patentable weight (i.e., claims 26 and 31 state “prior to assembling the sheathing panel to the roof rafters adjacent said eave and prior to connecting said plurality of shingles to the sheathing panel,” and claim 36 states, “prior to assembling the plywood sheathing panel to the roof rafters adjacent said eave.”) The examiner agrees with the applicant that process limitations may be incorporated into article claims to fully define the invention. Regardless of how the process limitations help in furthering define the invention itself, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, although the process limitations aid in defining the scope of the invention, the process limitations are given little patentable weight.

It is further noted that the claim 25 limitation that the water, vapor, and ice resistant layer is sprayed onto the sheathing panel is also given no patentable weight since it is directed at the method of forming the layer upon the sheathing panel.

### ***1.132 Declarations***

2. The declarations of Douglas Forester and Thomas Williams under 37 CFR 1.132 filed June 2, 2004 (which is equivalent to the declaration filed by the applicant on November 3, 2003) are insufficient to overcome the rejection of claims 9, 11-12, and 24-36 based upon Simpson et al., Harkness, Diamond, and Zickell et al. as set forth in the last Office action.

Although the examiner and applicant's representative previously discussed the possibility of using the "consisting of" language to further limit the claimed invention, the fact that the invention is pre-assembled versus assembled on a roof still fails to distinguish over the prior art of record. Upon searching the relevant case law concerning the distinction between pre-assembled and non pre-assembled structures, it is clear that insofar as the same structure is present, the method of formation is irrelevant. The examiner directs the applicant's attention to the rejections outlined below. The examiner further notes that the applicant continually relies on the method of formation to distinguish the claimed invention over the prior art -- whether or not the method of formation is patentable is a matter to be decided through prosecution of method claims, not article claims.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9 and 24 are rejected under 35 U.S.C. 112, first paragraph, for failing to be enable any person skilled in the art to which it pertains to make and use the invention. Claim 9 uses the closed claim language "consisting of" to define the article. Claim 24 then recites that the article further comprises an adhesive means for securing the vapor, water and ice resistant layer to the sheathing panel. It is improper to claim an invention in closed form and then further add additional components to the invention in dependant claims. The examiner suggests placing the

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limitation of claim 24 into claim 9 under the “consisting of” phraseology. Proper clarification and/or correction are required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9, 11-12, and 24-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's admitted prior art in view of Zickell et al. (#4,992,315).

The applicant explicitly states the following in their specification on pages 2-4:

The following is a simplistic overview of the process for assembling a roof. Sheathing is secured to the rafters or roof frame . . . [A] vapor-, water- and ice resistant layer is placed along the edges of the roof or eaves in lieu of [a] vapor barrier or tar paper. In addition, the vapor-, water- and ice-resistant layer is placed in other areas of the roof prone to water leakage, such as the valleys, in lieu of the vapor barrier or tar paper. The vapor- and water resistant layer usually comes in 3' rolls, and the industry standard is a 0.04' thick vapor-, water- and ice-resistant layer . . . After placing the tar paper and vapor-, water- and ice-resistant layer in the appropriate locations on the roof, shingles are placed thereon in an overlapping construction from the lower portion of the pitched roof to the peak of the pitched roof as previously explained.

Turning now to the vapor-, water- and ice-resistant layer, it is generally supplied in 3' wide rolls having an adhesive backing that adheres to the sheathing. The adhesive backing is temporarily protected with a plastic film, which is removed prior to assembly to the sheathing panel. In most cases, the vapor-, water- and ice-resistant layer is placed along the eaves, which are subjected to ice dams, and other problematic areas prone to leakage. These rolls are heavy and difficult to manipulate and carry up to the roof. Once on the roof, the roll is unrolled along the length of the roof that is to receive the vapor-, water- and ice-resistant layer. This process is very difficult to perform on a pitched roof and can be dangerous. The adhesive backing is exposed by peeling off the plastic film covering the adhesive on the back of the vapor-, water-, and ice-resistant layer. The vapor-, water- and ice-resistant layer is placed on the roof and secured thereto. This process is very difficult to perform on a pitched roof and can be dangerous

....

The present invention is directed to overcoming one or more of the problems or disadvantages set forth above.

Therefore, as detailed by the applicant, it is the process of forming the article of invention that allegedly distinguishes the claimed invention over the prior art, not the article itself. Nonetheless, based on the applicant's disclosure, several limitations are not explicitly clear from the prior art. The applicant's admitted prior art fails to explicitly state that the vapor-, water-, and ice-resistant layer seals around fasteners passing through the layer and the sheathing panel nor does the admitted prior art explicitly disclose the surface coverage of the vapor-, water, and ice-resistant material over the sheathing panel. Finally, the admitted prior art does not teach that the water-, vapor-, and ice-resistant layer is preassembled with the sheathing panel.

First, with regards to the surface coverage, the applicant's admit that the layer is placed in any appropriate location along the roof. Although it does not explicitly teach that the article either completely covers or covers approximately three-fourths of the first face of the sheathing panel, the admitted prior art explicitly states that the rolls generally come in 3' widths. Therefore, depending on the desired end product, it would have been obvious to change the size of the roofing material or the "appropriate location" of placement such that it either completely covers or covers three-fourths of the first face of the sheathing panel. Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the size of the article such that it either completely covers or covers three-fourths of the sheathing panel since such a modification would have involved a mere change in the size of a component – a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Second, with regards to the sealing properties of the water-, vapor-, and ice-resistant layers, the examiner first notes that such a sealing property would be an obvious function of the known prior art water-, vapor, and ice-resistant layers. Furthermore, even if the applicant disagrees, it is notoriously well known in the art to select polymeric material that has been sufficiently rubberized such that a seal is formed around roofing nail punctures as evidenced by Zickell et al. (Col. 3, lines 20-22). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of the applicant's admitted prior art and Zickell et al. since each of the aforementioned references are analogous insofar as providing weatherproof sealing material – Zickell et al. providing a comparative advantage insofar as providing a rubberized polymeric material that seals around nails driven through the layer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the applicant's admitted prior art to include a sufficient amount of rubberized polymeric material as taught by Zickell et al. in order to ensure that a seal will be formed around nails and other fasteners driven through the weatherproof layer.

Finally, with regards to the pre-assembled limitation of the invention, whether the invention is pre-assembled or assembled on the roof does not patentably distinguish the claimed invention over the applicant's admitted prior art. "Although in some instances a claim may validly describe a new product with some reference to the method of production, a patentee who does not distinguish his product from what is old except by reference, express or constructive, to the process by which he produced it, cannot secure a monopoly on the product by whatever means produced. Every patent for a product or composition of matter must identify it so that it

can be recognized aside from the description of the process for making it, or else nothing can be held to infringe the patent which is not made by that process.” General Electric Co. v. Wabash Appliance Corp., 304 U.S. 364, 373-74 (1938). The Court of Customs and Patent Appeals was presented with an equivalent case as presented here involving the claiming of a pre-assembled structure. The CCPA held the following:

It is admitted, as argued by the appellant, that this [Fifield] reference does not disclosed the claimed combination. The shim and the rail bars disclosed by Fifield are not connected to form a pre-assembled consolidated shimmed rail joint bar such as applicant has provided. 35 U.S.C. § 103(a) applies, however, to the situation where the invention is not identically disclosed or described as set forth in section 102 of this title and requires that a determination be made as to whether the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious.

...  
It seems to us that the Fifield shim and joint bar could be secured together as a preassembled unit by use of an adhesive and that such pre-assembly by use of an adhesive would be obvious to a person of ordinary skill in the art, in view of the use made of adhesives in Crowther and Fink to provide pre-assembled units of otherwise separate elements.

In re Lansing, 302 F.2d 772, 775-76 (CCPA 1962). Albeit only persuasive authority, the United States District Court for the Southern District of New York held in Fairfax Dental v. Sterling Optical Corp., 808 F. Supp., 326, 338 (1992), that:

Fairfax asserts that the hypothetical claim would be patentable over the prior art primarily because the pin is wholly manufactured and assembled in the factory as a complete device. That the dental pin in Fairfax’s hypothetical claim is “manufactured as a complete device” is not sufficient to make the claim patentable.

Ultimately, review of the aforementioned case law makes it clear that the mere fact that a claimed product is a pre-assembled structure does not patentably distinguish that product from a prior art article that is assembled otherwise. Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant’s invention was made to have formed the prior art



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combination consisting of the water-, vapor-, and ice-resistant layer and the sheathing panel as a pre-assembled structure.

7. Claims 9, 11-12, and 24-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (#5,096,759) in view of Harkness (#4,775,567), Diamond (#4,194,335), and Zickell et al. (#4,992,315).

Simpson et al. teach an article of manufacture for reducing water damage on a roof comprising a sheathing panel for assembling on the roof rafters having a first face and a second face (see Fig. 10), a high density polyethylene film layer (Col. 1, lines 50-56), an adhesive layer (Fig. 1, #24), and a plastic film covering the adhesive layer (Fig. 1, #26). The film covering the adhesive layer is removable to form a structure consisting of the sheathing panel in combination with the weatherproof film layer. The article comprises means for removing the plastic film to expose the adhesive backing and means for assembling the article to the sheathing panel (see Fig. 2; Col. 5, lines 55-62). The article comprises marking means for positioning a corner of the article at a corner of the sheathing panel and aligning their longitudinal edges (Col. 4, lines 8-17). Although Simpson et al. do not explicitly teach that the article either completely covers or covers approximately three-fourths of the first face of the sheathing panel, Simpson et al. teach that the roofing is manufactured to be wound into a spiral roll and cut to appropriate sizes. Therefore, depending on the desired end product, it would have been obvious to change the size of the roofing material such that it either completely covers or covers three-fourths of the first face of the sheathing panel (Col. 2, lines 4-9). Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the size of the article such that it either completely covers or covers three-fourths of the sheathing panel

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since such a modification would have involved a mere change in the size of a component – a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Simpson et al. further teach that the roofing material is arranged in such a way so as to prevent leaks (Col. 5, lines 43-47) but fail to explicitly state that the high density polyethylene film layer is water, vapor, and ice resistant.

Harkness, however, teaches a waterproofing laminate for use in roofs wherein the waterproofing laminate material is selected from multiple different polyethylene materials (Col. 3, lines 1-6). The waterproofing laminate is used for the purpose of resisting undesired penetration of water (“water” implicitly includes ice) and water vapor (Col. 2, lines 14-17). It would have been obvious through routine experimentation to one of ordinary skill in the art to select a polyethylene based material based on its waterproofing properties for the purpose of providing a roofing laminate that resists undesired penetration of water and water vapor as taught by Harkness.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant’s invention was made to have modified Simpson et al. to replace the high density polyethylene laminate with a polyethylene waterproofing laminate as taught by Harkness in order to provide a roofing laminate that resists undesired penetration of water and water vapor.

Simpson et al. further fail to teach whether the moisture barrier layer may be pre-assembled with the sheathing panel. Whether the invention is pre-assembled or assembled on the roof does not patentably distinguish the claimed invention over the teachings of Simpson et al. “Although in some instances a claim may validly describe a new product with some

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reference to the method of production, a patentee who does not distinguish his product from what is old except by reference, express or constructive, to the process by which he produced it, cannot secure a monopoly on the product by whatever means produced. Every patent for a product or composition of matter must identify it so that it can be recognized aside from the description of the process for making it, or else nothing can be held to infringe the patent which is not made by that process.” General Electric Co. v. Wabash Appliacnce Corp., 304 U.S. 364, 373-74 (1938). The Court of Customs and Patent Appeals was presented with an equivalent case as presented here involving the claiming of a pre-assembled structure. The CCPA held the following:

It is admitted, as argued by the appellant, that this [Fifield] reference does not disclosed the claimed combination. The shim and the rail bars disclosed by Fifield are not connected to form a pre-assembled consolidated shimmed rail joint bar such as applicant has provided. 35 U.S.C. § 103(a) applies, however, to the situation where the invention is not identically disclosed or described as set forth in section 102 of this title and requires that a determination be made as to whether the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious.

...

It seems to us that the Fifield shim and joint bar could be secured together as a preassembled unit by use of an adhesive and that such pre-assembly by use of an adhesive would be obvious to a person of ordinary skill in the art, in view of the use made of adhesives in Crowther and Fink to provide pre-assembled units of otherwise separate elements.

In re Lansing, 302 F.2d 772, 775-76 (CCPA 1962). Albeit only persuasive authority, the United States District Court for the Southern District of New York held in Fairfax Dental v. Sterling Optical Corp., 808 F. Supp., 326, 338 (1992), that:

Fairfax asserts that the hypothetical claim would be patentable over the prior art primarily because the pin is wholly manufactured and assembled in the factory as a complete device. That the dental pin in Fairfax’s hypothetical claim is “manufactured as a complete device” is not sufficient to make the claim patentable.

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Ultimately, review of the aforementioned case law makes it clear that the mere fact that a claimed product is a pre-assembled structure does not patentably distinguish that product from a prior art article that is assembled otherwise. Furthermore, the teachings of Diamond demonstrate that it was known in the roofing industry at the time applicant's invention was made to provide pre-assembled structures (see Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have formed the prior art combination consisting of the water-, vapor-, and ice-resistant layer and the sheathing panel as a pre-assembled structure.

Finally, Simpson et al. do not explicitly state that the polymeric weatherproof layer seals around fasteners passing through the layer. It is notoriously well known in the art, however, to select polymeric material that has been sufficiently rubberized such that a seal is formed around roofing nail punctures as evidenced by Zickell et al. (Col. 3, lines 20-22). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of Simpson et al. and Zickell et al. since each of the aforementioned references are analogous insofar as providing weatherproof sealing material – Zickell et al. providing a comparative advantage insofar as providing a rubberized polymeric material that seals around nails driven through the layer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Simpson et al. to include a sufficient amount of rubberized polymeric material as taught by Zickell et al. in order to ensure that a seal will be formed around nails and other fasteners driven through the weatherproof layer.

***Response to Arguments***

8. Applicant's arguments filed 6/2/04 have been fully considered but they are not persuasive.

The examiner first directs the applicant's to the new grounds of rejection above involving the case law set forth by the examiner in relation to pre-assembled structures.

Second, with regards to the applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981). The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

Here, taking the references as a whole, it is clear that the prior art teaches the use of weatherproof films that are placed on the sheathing panels in roofing substrates. The teachings of Diamond are merely cited as support for the fact that it is known in the roofing industry to provide pre-assembled structures. Whether or not the specific make-up of the roofing substrate in Diamond reads on the applicant's invention is immaterial – the fact that it is known to pre-fabricate roofing materials in combination with the cited case law directed at pre-assembled articles is sufficient to render the applicant's claimed invention obvious to one of ordinary skill in the art.


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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 571-272-1491. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BPE 8/15/04

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772 8/16/04